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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of **DiBiao et al**

Application No. 09/542,418

Attorney Docket No. 0412-P02120US0

Filed: April 4, 2000

For: System and Method for Automated
Document Processing

Examiner: Miller, Jonathan

Group Art Unit: 3653

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RESPONSE TO OFFICE ACTION

In an Official Action dated November 18, 2003, the Examiner imposed a restriction requirement between 4 groupings of claims. Applicants' undersigned attorney respectfully traverses the new election requirement.

This application apparently has been transferred to the present Examiner after the case has been pending for over 3-1/2 years. Applicants were subjected to a restriction requirement and two substantive official actions by the previous examiner. Now Applicants are being subjected to yet another restriction requirement after all of the time and expense that were expended dealing with the previous examiner. Such action is unfair and is contrary to the MPEP.

MPEP §808.01 states that an election requirement is to be imposed prior to a search on the merits. Furthermore, MPEP §704.01 states that an Examiner's search and prior action is entitled to full faith and credit by a subsequent Examiner. The new Examiner may disagree with the earlier Examiner's election, but that is not enough under the MPEP guidelines. If there is no deference given to the previous Examiner, then there is a complete waste of both the PTO's and Applicants' time and resources.

If the previous Examiner defined the class broader than he could have, the burden should be on the PTO to bear that determination, not Applicants. The scope of an election requirement is not a substantive requirement. It is for the convenience of the PTO. By requiring Applicants to start all over with a new election requirement, the PTO is shifting onto Applicants the burden caused by the previous Examiner. Why should such that burden be shifted to Applicants? Applicants complied with the previous Examiner's request. In fact, Applicants were willing to comply with the new Examiner's request to restrict the claims to claims 14-19 and 48-63. Now even that election requirement has been changed. This just shows that reasonable minds can differ on the scope of an election requirement. That is exactly why MPEP §704.01 directs an examiner to give full faith and credit to a previous examiner's search.


Requiring a new election at this point ignores the fact that two substantive actions have already occurred, and gives no credence to the previous Examiner's search. Although the new Examiner believes that the previous Examiner may have defined the species too broad, requiring a new election unfairly shifts the burden of that decision to Applicants. Accordingly, Applicants respectfully request that the Examiner reconsider the imposition of the new election requirement.

Alternatively, Applicants are willing to accept the previous election requirement that the present Examiner communicated to Applicants' undersigned attorney last

month, which would be an election of claims 14-19 and 48-63. In addition, in order to make this response complete, Applicants elect Group IV, which includes claims 54-63.

Respectfully submitted,

DANN, DORFMAN, HERRELL & SKILLMAN
A Professional Corporation
Attorneys for Applicant(s)

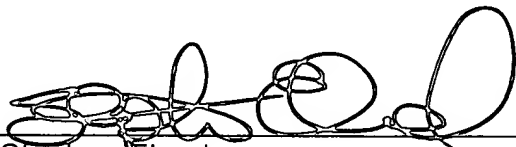
By 
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CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this Response and accompanying papers are being deposited on **December 18, 2003** with the United States Postal Service as first-class mail in an envelope properly addressed to Commissioner for Patents, Alexandria, VA 22313-1450.

December 18, 2003
Date of Certificate


Stephen Eland